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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,407	12/02/2004	Elisha Moses	P-7448-US	1416
49443	7590	06/01/2006	EXAMINER	
PEARL COHEN ZEDEK, LLP 1500 BROADWAY 12TH FLOOR NEW YORK, NY 10036			SMITH, JOHNNIE L	
			ART UNIT	PAPER NUMBER
			2881	

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/516,407	MOSES ET AL.	
	Examiner	Art Unit	
	Johnnie L. Smith II	2881	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-23, 31-35 and 44-46 is/are rejected.
- 7) ☒ Claim(s) 24-30 and 36-43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>0902</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 21, 23, 31-35, and 44-46 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 4,705,949 (Grimes, II et al). In reference to claims 21 and 34, Grimes teaches a specimen enclosure assembly for use in an electron microscope (column 2 lines 24-31) and comprising: a specimen enclosure dish having an aperture and defining an enclosed specimen placement volume; an electron beam permeable, fluid impermeable, cover sealing said specimen placement volume at said aperture from a volume outside said specimen enclosure assembly (column 5 lines 12-24); and a pressure controller communicating with said enclosed specimen placement volume, said pressure controller being configured for maintaining said enclosed specimen placement volume at a pressure which exceeds a vapor pressure of a sample in said specimen placement volume and is greater than a pressure of a volume outside said specimen enclosure

assembly, wherein a pressure differential across said cover does not exceed a threshold level at which rupture of said cover would occur (column 5 line 60-column 6 lines 10).

3. In reference to claim 23, Grimes teaches a specimen enclosure assembly wherein said pressure controller comprises a passageway communicating with said enclosed specimen placement volume (column 5 line 60-column 6 line 10).

4. In reference to claims 31-33 and 44-46, Grimes teaches a specimen enclosure also comprising a fluid ingress and egress (66, 64) assembly permitting supply and removal of fluid from said enclosed specimen placement volume; wherein said fluid ingress and egress assembly comprises at least two fluid conduits; and wherein said at least one fluid conduit of said fluid ingress and egress assembly comprises at least two tubes (figure 4 and column 5 lines 49-59).

5. In reference to claim 35, Grimes teaches a method wherein said providing said pressure controller comprises forming in said specimen enclosure assembly a passageway communicating with said volume outside said specimen enclosure assembly (column 5 line 60-column 6 line 10).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over US patent 4,705,949 (Grimes, II et al). Grimes fails to teach applicant's element of having a specimen enclosure assembly wherein said specimen enclosure dish is a rigid specimen enclosure dish. However since applicant fails to teach a novel or specific function of the claimed rigid specimen dish, the claimed elements is

considered an art-recognized equivalent, and one of ordinary skill in the art would have found it obvious to substitute at the time the invention was made.

Claim Objections

9. Claims 24-30 and 36-43 are objected to as being dependent upon a rejected base claim.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All of the references cited on attached PTO 892 contain art similar to that being claimed by applicant, more specifically, methods and apparatuses for scanning electron microscopes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnnie L. Smith II whose telephone number is 571-272-2481. The examiner can normally be reached on Monday-Thursday 6-4 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Lee can be reached on 571-272-2477. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JLSII

Johnnie L Smith II
Examiner
Art Unit 2881



KIET T. NGUYEN
PRIMARY EXAMINER